

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 20-23 and 38-39.

The following claims are *independent*: 20-21 and 38-39.

Please *add* claims 40-45 and *amend* claims 20-21 and 38-39; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 20-21 and 38-39 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Although Applicant respectfully traverses the rejection(s), and submits that the noted claims satisfy the requirements of 35 U.S.C. § 112, Applicant submits amended claims 20-21 and 38-39 also comply with 35 U.S.C.

§ 112. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 20-23 and 38-39 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Himmelstein, US Patent Publication No. 2002/038278 (hereinafter “Himmelstein”), and in further view of Russo, US Patent Publication No. 2004/068458 (hereinafter “Russo”).

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.” *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

(A) the relevant teachings of the prior art relied upon, preferably

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

with reference to the relevant column or page number(s) and line number(s) where appropriate;
(B) the difference or differences in the claim over the applied reference(s);
(C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements, at least, (A) and (B), and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following elements as recited, *inter alia*, in currently amended independent claim 20:

A processor implemented method , comprising:
... receiving via the processor a user defined selection of a
second order destination alternative from said order

destination menu, the second order destination alternative representing a second order destination;

determining via the processor, based at least in part on the second order destination alternative selected by the user, at least one order type alternative that represents order types supported by the second order destination, the at least one order type alternative being different from the order type alternatives listed in the first order type menu and displayed as part of a second order type menu;....

The Office Action confirms that the above claim elements are not explicitly disclosed in Himmelstein and turns to Russo to remedy the deficiency. (Office Action, p.5, ¶1) However, Applicant respectfully disagrees and submits that Russo also fails to discuss or render obvious the claimed elements recited in amended independent claim 20.

Instead of the Office Action's assertions, Applicant submits that Russo discusses a fixed sequence of data input requests ("command instructions") that are populated independently from any user inputs. For example, Applicant notes that Russo discusses requesting data from the user, "...WHAT SYMBOL[?]" and in response to the request, "...the 'user' of the machine types in the desired stock symbol...." (Russo, FIG. 064; para. [0238]). Next, regardless of what stock symbol is entered, Russo's system requests, "HOW MANY SHARES[?]" and "the 'user' of the machine types in the quantity of stock shares...." (Russo, FIG. 067; para. [0238]). Further, Applicant notes that Russo's system makes similar independent input requests for the "BUY PRICE" and "SELL PRICE." (Russo, FIG. 072; para. [0238]). Accordingly, Applicant submits that Russo's predetermined data requests that are user input independent are fundamentally different from the claimed, "receiving... a user defined selection of a second order destination **alternative from said order**

destination menu... determining..., based at least in part on the second order destination alternative selected by the user, at least one order type alternative associated with the second order destination, the at least one order type alternative being **different** from the order type alternatives listed in the first order type menu and **displayed as part of a second order type menu,”** as recited in amended independent claim 20. (Emphasis added).

For at least the reasons discussed above, Applicant submits that the pending rejection has mischaracterized the cited references as applied to the claim elements and, thus, has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Although of different scope than independent claim 20, Applicant submits claims 21 and 38-39 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Himmelstein in view of Russo with regard to independent claim 20. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office

action(s)) (hereinafter “Office Action(s)”). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary.

Further, any remarks that were made in response to the Office Action(s)’ objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks.

Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any Official Notice that has been taken and/or (mis)characterizations of claims made in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of

the cited reference(s) and/or any Official Notice in the Office Action(s).

Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 20-23 and 38-39, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-452. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-452.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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